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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/470,452	12/22/1999	JOHN G. POSA	POS-01102/29	6162

7590 12/03/2002
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EXAMINER

VO, HAI

ART UNIT	PAPER NUMBER
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1771

DATE MAILED: 12/03/2002

9

Please find below and/or attached an Office communication concerning this application or proceeding.

AS9

Office Action Summary	Application No. 09/470,452	Applicant(s) POSA ET AL.	
	Examiner Hai Vo	Art Unit 1771	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 9-19 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 9-19 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
 If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
 * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
 a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____. | 6) <input type="checkbox"/> Other: _____ |

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 9-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over the prior art of figure 1 as admitted by the Applicant on page 5, lines 11-15 of the present invention (herein after referred to as the admitted prior art) in view of Heilman et al (US 5,474,194) substantially as set forth in Paper no. 7. With regard to claim 18, since the admitted prior art discloses a conventional packing tape meeting all the limitations of structure of the claimed subject matter except an edge of the tape that becomes visibly apparent when the tape is cut or torn (Figure 1, page 5, line 10-18 of the specification), the nature of the flexible backing layer is anticipatory, i.e., made of a polymer selected from the group consisting of polyester, polyvinyl, cellulosic polymers, polyvinylidene and combinations thereof.

With regard to claim 19, Heilman discloses a color change system including a brittle layer **44** formed of a flexible material and being colored with a fluorescent dye (figure 5, column 3, lines 33-48, and column 4, lines 1-10). It would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate a fluorescent dye into the backing layer of the conventional packing tape motivated by the desire to generate an irreversible color change at the edge of the tape when

the tape is cut. Claims 18 and 19 have been rejected under 35 U.S.C. 103(a) as being unpatentable over the admitted prior art in view of Heilman et al (US 5,474,194). However, the examiner made a typo mistake by not including them in Paper no. 7. The examiner would like to apologize for any inconvenience that may have been caused. Further, the examiner agrees that the conventional packing tape is meeting all the limitations of structure of the claimed subject matter, not limitations of chemistry of the claimed subject matter because no fluorescent substances are included in the backing layer of the tape.

3. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over the prior art of figure 1 as admitted by the Applicant on page 5, lines 11-15 of the present invention (herein after referred to as the admitted prior art) in view of Heilman et al (US 5,474,194) as applied to claim 1 above, further in view of Powell et al (US 3,819,398) substantially as set forth in Paper no. 7.

Response to Arguments

4. Applicant's arguments filed 09/26/2002 have been fully considered but they are not persuasive.
5. The art rejections in Paper no. 7 have been maintained because of the following reasons. At the first place, Applicants arguments are not commensurate in scope with the claims. The admitted prior art has all the limitations except the fluorescent material in the backing layer of the packaging tape. Heilman supplies the missing fluorescent material in the backing layer of the conventional packaging tape. Heilman discloses the color change system comprising a brittle layer and the

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bonding layer (column 3, lines 33-48, and column 4, lines 1-10). The brittle layer can be made of epoxy functional polyacrylate which is tough and **flexible** allowing it to withstand shipping and handling abuse (column 3, lines 56-60). The brittle layer has the fluorescent material that ruptures upon a mechanical action. The analogy of the brittle layer and the bonding layer of Hielman to the backing layer and the adhesive layer of the claimed invention would motivate one of skill in the art to employ a fluorescent dye in the backing layer, **not** the adhesive layer of the conventional packing tape to generate an irreversible color change at the edge of the tape when the tape is cut or torn (the color capsule in the backing layer cracks up as part of a tamper-evidence). The analogy absolutely has nothing to do with the nature of the backing layer and the adhesive layer of the claimed invention. Since Hielman is a secondary reference, the nature of the brittle layer and the bonding layer in Hielman does not need to be exactly the same as that of the backing layer and the adhesive layer of the claimed invention. The nature of these layers has been taught in the admitted art. Second, Applicants argues that very small particles of microcapsules becomes exposed in contrast to a macroscopic structure cracking due to being brittle. This is not found to be persuasive. The examiner interprets when the conventional packing tape is cut or torn, some color capsules located along the line of the tape being cut break apart and the color is consequently generated at the line where the tape is cut or torn. As a result, the rupture of the color capsules does not lead to a macroscopic structure cracking as Applicants argue.

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In response to applicant's argument that Hielman and Powell references non-analogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, the combination of the admitted prior art with Hielman does solve the problem associated with which the applicant was concerned. One would be motivated to include the fluorescent material in the backing layer of the tape to generate the color change when the tape is cut (Hielman column 4, lines 6-8). Powell teaches a fluorescent dye in form of the microcapsule being employed in an adhesive tape (column 1, lines 11-22). One would be motivated to employ a fluorescent dye in form of a microcapsule into the backing layer to provide a color change at the edge of the tape upon destruction of the microcapsules when the tape is cut (Powell, column 1, lines 53-55). Putting these things together, the art rejections in Paper no. 7 have been sustained.

Conclusion


6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hai Vo whose telephone number is (703) 605-4426. The examiner can normally be reached on Tue-Fri, 8:30-6:00 and on alternating Mondays.
- If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached on (703) 308-2414. The fax phone

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numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

HV
December 2, 2002



TERREL MORRIS
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1700